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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/911,592
Filing Date: July 24, 2001
Appellant(s): HOEFELMEYER ET AL.

Phouphanomketh Ditthavong
Reg. No. 44,658
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 11/29/07 appealing from the Office action mailed on 10/02/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Application serial No. 10/024,202.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|--------------|----------|---------|
| 2003/0191957 | HYPPONEN | 10-2003 |
| 7,010,807 | YANOVSKY | 03-2006 |

Network Associates, Inc., "Network Associates Ships CyberCop Sting- Industry's First 'Decoy' Server Silently Traces and Tracks Hacker Activity", July 14, 1999. All pages.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 5, 8, and 10 are provisionally rejected on the ground of nonstatutory double patenting over claims 1, 4, 7, 11 and 14 of copending Application No. 10/024,202. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: co-pending applications and present application disclose a scanning system, an anti-virus server, and a switch for performing the same virus protection procedures. The instant claims are broader in scope to the claims for co-pending application and are therefore anticipated from them.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 5, 6, 8 and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyponen et al. U.S. Pub. No. 20030191957 (hereinafter Hyponen) in view of Yanovsky U.S. Pat. No. 7010807 (hereinafter Yanovsky).

As per claim 1, 5, 8, and 10,, Hyponen discloses a network security system to be deployed between a plurality of network (intranet) belonging to respective organizations and an internet backbone, comprising: a scanning system coupled to the network (intranet) for scanning incoming electronic mail for malicious code (Hyponen: [0011]: virus scanning server), and a switch coupled between the internet backbone and the scanning system (Hyponen: figure 1 and

[0012] and [0013]: transit nodes 4a); said switch configured for: directing incoming electronic mail from the internet backbone to the scanning system (Hypponen: [0008]-[0009]: directing the data from transit node to scanning server). Hypponen does not explicitly disclose an anti-virus server coupled to the network (intranet) for downloading anti-virus code to clients coupled to the network (intranet). However, Yanovsky discloses an internet access module for updating anti-virus protection on network devices by periodically updating network devices (Yanovsky: column 1 line 66 – column 2 line 11). It would have been obvious to one having ordinary skill in the art to utilize the internet access module/anti-virus server and the scanning server as an anti-virus system to be coupled to a transit node/switch because providing virus scanning and virus code update are well known features of anti-virus systems and both prior art discloses protection of local area network/intranets. It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Yanovsky within the system of Hypponen because it ensure anti-virus software residing on network devices are up-to-date (Yanovsky: column 2 lines 10-11). Furthermore, although Hypponen does not explicitly disclose the switch is coupled to a plurality of intranets, Hypponen discloses the users (2a-2d) includes number of workstations, servers and administrators, each of which potentially serve in another intranet as one with ordinary skill in the art would understand (Hypponen: [0031] and figure 1). Therefore, it would have been obvious to one having ordinary skill in the art to apply the intranet anti-virus system to plurality of intranets to reduce the cost of implementing a separate system for each intranet.

As per claim 3, Hypponen discloses a network security system to be deployed between a plurality of network (intranet) belonging to respective organizations and an internet backbone, comprising: a scanning system coupled to the network (intranet) for scanning incoming electronic mail for malicious code (Hypponen: [0011]: virus scanning server); a mail proxy server for determining whether the incoming electronic mail is to be scanned for malicious code and directing the incoming electronic mail to the scanning system when the incoming electronic mail is determined to be scanned for malicious code (Hypponen: [0032] and [0036]: the data is routed from Internet via firewall 4a to mail server); and a switch coupled between the internet backbone, and the scanning system (Hypponen: figure 1 and [0012] and [0013]: transit nodes); said switch configured for: directing incoming electronic mail from the internet backbone to the mail proxy server (Hypponen: [0032]: pass data from firewall to mail server). Hypponen does not explicitly disclose an anti-virus server coupled to the network (intranet) for downloading anti-virus code to clients coupled to the network (intranet). However, Yanovsky discloses an internet access module for updating anti-virus protection on network devices by periodically updating network devices (Yanovsky: column 1 line 66 – column 2 line 11). It would have been obvious to one having ordinary skill in the art to utilize the internet access module/anti-virus server and the scanning server as an anti-virus system to be coupled to a transit node/switch because providing virus scanning and virus code update are well known features of anti-virus systems and both prior art discloses protection of local area network/intranets. Furthermore, although Hypponen does not explicitly disclose the switch is coupled to a plurality of intranets, it would have been obvious to one having ordinary skill in the art to apply the intranet anti-virus system to plurality of intranets to reduce the cost of implementing a separate system for each

intranet. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Yanovsky within the system of Hypponen because it ensure anti-virus software residing on network devices are up-to-date (Yanovsky: column 2 lines 10-11).

As per claim 6 and 11, Hypponen as modified discloses the network security system according to claims 5 and 10 respectively. Hypponen as modified further discloses load-balancing among the scanning systems and proxy servers (Hypponen: [0043]).

As per claim 12-15, Hypponen as modified discloses the system of claims 1, 3, 8, 10 respectively. Hypponen as modified further disclose a hub in communication with the scanning system and the intranets, wherein the scanning system is further configured for sanitizing at least some of the incoming electronic mail addressed to recipients on the intranets and directing the sanitized incoming electronic mail to the recipients via the hub (Hypponen: [0038] and [0042]: disinfect the files)

Claims 2, 4, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hypponen in view of Yanovsky and further in view of Network Associates, Inc. "Network Associates Ships Cybercop Sting- Industry's first 'Decoy' Server Silently Traces and Tracks Hacker Activity" (hereinafter NAI).

As per claim 2, 4, 7, and 9, Hypponen as modified discloses the system of claims 1, 3, 5, and 8 respectively. Hypponen as modified does not explicitly disclose a decoy server coupled to the intranets for masquerading as a legitimate server and logging activity on communications received via the internet backbone; wherein the switch is further coupled to the decoy server and is further configured for redirecting suspicious traffic from the internet backbone to the decoy server. However, NAI discloses decoy server is used to trace and track hackers and reporting all intrusive activities (NAI: page 1). It would have been obvious one having ordinary skill in the art to include decoy server into the anti-virus system because Hypponen and NAI both are applied within a network anti-virus environment. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of NAI within the combination of Hypponen-Yanovsky because it provides additionally security measure to web clients.

(10) Response to Argument

Regarding claims 1, 3, 5, 8, and 10, appellant argues that the claims are not obvious over claims 1, 4, 7, 11, and 14 of co-pending application serial No. 10/024,202.

Regarding appellant's argument on the double patenting rejection, an earlier patent is not patentably distinct from a later patent claim if the earlier claim is obvious over, or anticipated by, the later claim. In this application, claims 1, 3, 5, 8, and 10 are generic to the species of invention covered by claims 1, 4, 7, 11 and 14 of the co-pending application #10/024,202. Thus, the generic invention is "anticipated" by the species of the patent/application #10/024,202. Cf., *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an

earlier species disclosure in the prior art defeats any generic claim). This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claim(s) XX were properly rejected under the doctrine of obviousness-type double patenting. " (In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993)).

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus)." ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Regarding claims 1, 3, 5, 6, 8, and 10-15, appellant argues that the prior art of record does not disclose the claimed "plurality of intranets".

Regarding the argument, the examiner has indicated that the Hypponen reference discloses a network infrastructure that connects an intranet of devices to a switch coupled to the Internet (Hypponen: figure 1: intranet 3 and internet 5; [0032]: network infrastructure that allows different devices in the network). Although Hypponen does not explicitly disclose a network

infrastructure that comprises a plurality of intranets, the mere duplication of parts (intranets) has no patentable significance unless a new and unexpected result is produced (*In re Harza*, 274 F.2d 669, 124 USPQ 378). In this instance, the plurality of intranets as claimed does not affect operations of the network protection system.

On the other hand, appellant agrees that Hypponen discloses a centralized virus scanning process (Appeal Brief: page 14 line 2). To one having ordinary skill in the art, a centralized virus scanning process provides service to a plurality of entities. Although "a plurality of intranets" is not explicitly recited in the prior art, one with ordinary skill in the art would understand the system of Hypponen would operate equally with a single intranet or a plurality of intranets because a centralized virus scanning system is intended to serve a plurality of nodes whether from a single intranet or a plurality of intranets.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 2132

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Shin-Hon Chen/
Examiner, Art Unit 2131

/Gilberto Barrón Jr./
Supervisory Patent Examiner, Art Unit 2132

Conferees:

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